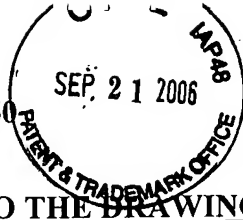


Application No.: 10/613,050



AMENDMENTS TO THE DRAWINGS:

Please replace Fig. 7 with the new Fig. 7 on the enclosed copy thereof. Fig. 7 has been amended to properly reflect the amended description set forth on page 2, lines 13-21 of the specification which indicates the correct connections of the two ground leads 804a and 804b. The original included inadvertent typographical errors.

REMARKS

I. Introduction

In response to the pending Office Action, Applicants have amended claim 1 to further clarify the intended subject matter of the invention. Support for the amendment to claim 1 can be found, for example, on page 26, lines 4-6 of the specification. In addition, Fig. 7 and the related portions of the specification (page 2, lines 13-21) have been amended to correct the unclear description of the prior art as suggested in the Office Action. No new matter has been added.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art.

II. The Rejection Of Claims 1, 4 And 5 Under 35 U.S.C. § 103

Claims 1, 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Admitted Prior Art in view of Hayashi (USP No. 6,359,235) in view of Jones (USP No. 5,227,583) and further in view of Lamson et al. (USP No. 6,563,208). Applicants respectfully traverse this rejection for at least the following reasons.

Claim 1 recites, in-part, a printed wiring board comprising...an auxiliary lead which is provided on the insulating board while the auxiliary lead is not in electrical contact with the signal transmitting lead, the auxiliary lead is not in electrical contact with a ground lead; and an electromagnetic shielding layer made of a magnetic material having magnetic loss which covers at least a part of the auxiliary lead, wherein a signal is not carried to the auxiliary lead.

In contrast to the claimed invention, neither the APA, Hayashi, Jones or Lamson teach or suggest an auxiliary lead that is not in electrical contact with a ground lead. The APA, as shown

in Fig. 7, and Hayashi both fail to disclose the concept of an auxiliary lead. In Fig. 7 of the present invention, which describes the prior art, the two ground leads, 804a and 804b are connected with a via 808. There is no mention of an auxiliary lead. Hayashi is also appears silent with regard to an auxiliary lead as arranged in the manner set forth in the claims.

Jones discloses that the first electrically conductive metallic plate (the alleged auxiliary lead) 26 is electrically connected to the first bus 20 (see, Jones, col. 5, lines 59-61). However, the alleged auxiliary lead of Jones is in electrical contact with the first bus 20, which can be a ground. Thus, Jones fails to disclose the limitation in claim 1 that the auxiliary lead is not in electrical contact with a ground lead. Similarly, Lamson also teaches that each of the auxiliary leads 402 are connected to a ground contact 407 (see, Lamson, col. 3, lines 54-56). Thus, none of the cited prior art references, alone or in combination, teach the limitation that the auxiliary lead is not in electrical contact with a ground lead.

According to one aspect of the present invention, in view of the claimed limitations, the present invention makes it possible to reduce electromagnetic noise.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA1974). As neither the APA, Hayashi, Jones or Lamson fail to teach or suggest that the auxiliary lead is not in electrical contact with the ground lead, it is submitted that the APA, Hayashi, Jones and Lamson, either alone or together do not render claim 1 obvious. Accordingly, it is respectfully requested that the § 103 rejection of claim 1, and any pending claims dependent thereon be withdrawn.

**III. All Dependent Claims Are Allowable Because The
Independent Claim From Which They Depend Is Allowable**

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

IV. Conclusion

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication of which is respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Michael E. Fogarty
Registration No. 36,139

Please recognize our Customer No. 20277
as our correspondence address.

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 MEF/NDM:kap
Facsimile: 202.756.8087
Date: September 21, 2006